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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,118	08/22/2001	Mehmet Karaul	3376/46	8350
29858	7590	06/14/2005		
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022				
			EXAMINER PHUNKULH, BOB A	
			ART UNIT 2661	PAPER NUMBER

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

511

Office Action Summary	Application No.	Applicant(s)	
	09/935,118	KARAU ET AL.	
	Examiner	Art Unit	
	Bob A. Phunkulh	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 17 and 22, it is not clear what it meant by "a Mobile Station ISDN associated with the second device" as cited in the claim i.e. ISDN is Integrated Services Digital Network with two standards Basic Rate Interface and Primary Rate Interface. What is the mobile station ISDN?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 14-20, 22-25, 27-30, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Gentry et al. (US 6,888,803), hereinafter Gentry.

Art Unit: 2661

Regarding claim 1, Gentry discloses a telecommunication system that allows communication between a circuit-based wireless telephony network and a packet-based Internet telephony network, the system comprising:

a circuit-based wireless telephony network providing wireless access to the system (the combination of BSC 210, a plurality of BTS, see figure 2);

a packet-based Internet telephony network providing Internet telephony access to the system (packet data or IP network 100, see figure 2); and

a base station gateway controller for providing an interface between the wireless telephony network and the Internet telephony network (BGW gateway 200, see figure 2).

Regarding claim 2, Gentry discloses the system does not require utilization of the Public Switched Telephone Network (see figure 2).

Regarding claim 3, Gentry discloses the base station gateway controller is controlled by a call processing engine (see figure 2 and col. 2 lines 37-53).

Regarding claim 4, Gentry discloses the base station gateway controller provides a data signal transport gateway between circuit-based data and packet-based data (as shown in figure 2, the BSC gateway 200 is a data signal transport gateway between the IP network 100 and mobile network, see figure 2).

Regarding claim 5, Gentry discloses the circuit-based data and the packet based data are voice data (see col. 6 lines 1-20).

Regarding claim 6, Gentry discloses the base station gateway controller is configured to perform vocoding functions to translate between different data coding schemes (see col. 6 line 1-20).

Regarding claim 7, Gentry discloses a packet-based mobile switching center communicatively connected with the base station gateway controller (MSC gateway 400, see figure 2).

Regarding claim 8, Gentry discloses a packet-based mobile switching center communicatively connected with the base station gateway controller (MSC gateway 400, see figure 2);

and one or more circuit-based base station controllers communicatively connected to the base station gateway controller, wherein the base station gateway controller is utilized as a media gateway for communications between the mobile switching center and the one or more base station controllers (the BSC gateway 200 connected to the BSC 210, see figure 2).

Regarding claim 9, Gentry discloses the base station gateway controller provides a data signal transport gateway between circuit-based data and packet-based data (the

Art Unit: 2661

BSC gateway 200 provides a data transport gateway between the IP network 100 and the BSC 210 and the plurality of BTS, see figure 2).

Regarding claim 10, Gentry discloses the communications are voice data communications (see col. 6 lines 1-20).

Regarding claim 11, Gentry discloses the base station gateway controller is configured to perform vocoding functions to translate between different data coding schemes (see col. 6 lines 1-20).

Regarding claim 12, Gentry discloses the circuit-based wireless telephony network is a Global System for Mobile Communications network (see col. 6 lines 1-20).

Regarding claim 14, Gentry discloses the Internet telephony network is an Internet Protocol network (IP network 100, see figure 2).

Regarding claim 15, Gentry discloses the Internet Protocol network is a Session Initiation Protocol network (see col. 6 lines 1-20).

Regarding claim 16, Gentry discloses the Internet Protocol network is a H.323 network (see col. 6 lines 1-20).

Regarding claims 17, 22, Gentry discloses a method for facilitating communication between a first device, the first device being a packet-based Internet telephony network based device, and a second device, the second device being a circuit-based wireless telephony network based device, by facilitating connection of a call from the first device to the second device, the method comprising:

registering, at a serving Mobile Switching Center, a Mobile Station ISDN associated with the second device (table 1 includes the mobile identification number to home mobile switching center (MSC) mapping, see col. 7 lines 14-16) ;

utilizing an Enum database to map the Mobile Station ISDN to a Session Initiation Protocol address associated with a home Session Initiation Protocol Registrar associated with the second device (the basic rate interface subscriber profile index (tropical an E.164 directory number) is maintained the HLR, see col. 5 lines 31-35);

obtaining, at the Mobile Switching Center, the Session Initiation Protocol address (IP address from table 3, see col. 7 lines 443-55); and

utilizing the Session Initiation Protocol address in connecting the call.

Regarding claims 18, 23, Gentry discloses the method comprises utilizing a modified registration procedure (see col. 2 lines 54-62).

Regarding claim 19, Gentry discloses the method comprises utilizing a modified mobile switching station (as shown in figures MSC gateway 400, see figure 2).

Regarding claims 20 and 25, Gentry discloses the second device is based on a Global System for Mobile Communications network (see col. 6 lines 1-20).

Regarding claim 24, Gentry inherently discloses the method comprises utilizing a modified Session Initiation Protocol proxy server (the VOIP uses SIP protocol for voice call (see col. 2 lines 17, col. 4 lines 1-10); the base station controller gateway 200 functions as SIP proxy server (see col. 5 line 66 to col. 6 line 20).

Regarding claim 27, Gentry discloses a method for facilitating communication between a first device, the first device being a packet-based Internet telephony network based device, and a second device, the second device being a circuit-based wireless telephony network based device, by facilitating connection of a call from the first device to the second device, the method comprising:

receiving, at a Home Location Register, a first network address associated with a serving Mobile Switching Center associated with the second device (see col. 5 lines 22-40);

utilizing an Enum database to map the first network address to a Session Initiation Protocol domain name (table 1 col. 7 lines 14-26);

receiving, at a Home Location Register, the Session Initiation Protocol domain name (see col. 5 lines 22-40);

Art Unit: 2661

receiving, at a Session Initiation Protocol proxy server, an invite to connect the call (the BGW functions as SIP proxy server between SIP based IP network 100 and GSM based for VOIP call, see col. 5 line 66 to col. 6 lines 1-20 and figure 2)

the Session Initiation Protocol proxy server querying the Home Location Register to obtain the Session Initiation Protocol domain name (see col. 6 lines 1-20); and

utilizing the Session Initiation Protocol domain name in connecting the call (see col. 6 lines 1-20).

Regarding claim 28, Gentry discloses the method comprises a modified registration procedure and a modified call set up procedure (see col. 2 lines 54-62).

Regarding claim 29, Gentry discloses the method comprises utilizing a modified Home Location Register (see col. 7 lines 14-26).

Regarding claim 30, Gentry discloses the second device is based on a Global System for Mobile Communications network (see col. 6 lines 1-20).

Regarding claim 32, Gentry discloses the first network address is an E.164 address (see col. 5 lines 22-40).

Regarding claim 33, Gentry discloses a method for facilitating communication between a first device, the first device being a packet-based Internet telephony network

Art Unit: 2661

based device, and a second device, the second device being a circuit-based wireless telephony network based device, by facilitating connection of a call from the first device to the second device, the method comprising:

a registration procedure, comprising:

receiving, at a Home Location Register, a first network address associated with a serving Mobile Switching Center associated with the second device (see col. 5 lines 22-40);

utilizing an Enum database to map the first network address to a Session Initiation Protocol domain name (see col. 5 lines 22-40 and col. 7 lines 14-26); and

receiving, at a Home Location Register, the Session Initiation Protocol domain name; and

a call set up procedure, comprising:

receiving, at a Session Initiation Protocol proxy server, an invite to connect the call (the GBW 200 functions as SIP proxy server);

the Session Initiation Protocol proxy server querying the Home Location Register to obtain the Session Initiation Protocol domain name (see col. 5 line 66 to col. 6 line 1-20); and

utilizing the Session Initiation Protocol domain name in connecting the call.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2661

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 21, 26, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry in view of Toskala et al. (US 6,650,905), hereinafter Toskala.

Regarding claims 13, 21, 26, 31, Gentry fails to explicitly disclose that the circuit-based wireless telephony network is UMTS network.

Toskala, on the other hand, discloses the Universal Mobile Telecommunications System (UMTS) is to be the third generation mobile system, which is to offer higher data rates and a wide range of telecommunications services, including support for multimedia. UMTS will provide high-quality services with efficient use of network resources. UMTS is to be based on the Global System for Mobile communications (GSM) with some major modifications, e.g., a new radio interface. The UMTS network is to support both circuit-switched and packet-switched services. The circuit-switched technology will be based on the current GSM circuit-switched technology and the packet-switched technology on the General Packet Radio Service (GPRS), which is a new packet service for GSM (see col. 1 line 15-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made replace the GSM network with UMTS network for UMTS offer higher data rates and a wide range of telecommunications services, including support for multimedia and provide high-quality services with efficient use of network resources.

Conclusion

Any response to this action should be mailed to:

The following address mail to be delivered by the United States Postal Service (USPS) only:

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Arlington, VA 22202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bob A. Phunkulh** whose telephone number is **(571) 272-3083**. The examiner can normally be reached on Monday-Tuesday from 8:00 A.M. to 5:00 P.M. (first week of the bi-week) and Monday-Friday (for second week of the bi-week).

Art Unit: 2661

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor **Chau Nguyen**, can be reach on **(571) 272-3126**. The fax phone number for this group is **(703) 872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bob A. Phunkulh

A handwritten signature in black ink, appearing to read 'Bob A. Phunkulh', with a horizontal line drawn underneath the first part of the signature.

TC 2600

Art Unit 2661

June 13, 2005